| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/706,066 | 11/12/2003 | Erol Bozak | 13913-143001 / 2003P00468 | 6345 |

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| 22852        7590        07/31/2007 | | EXAMINER |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP | | CHEEMA, UMAR |
| 901 NEW YORK AVENUE, NW | ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>12 November 2003</u>.

2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-8</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-8</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>12 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>See Continuation Sheet</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :06/14/05, 04/07/04, 04/23/04, 03/11/04.

## DETAILED ACTION

### Information Disclosure Statement

1.      The information disclosure statements (IDS) submitted on 06/14/05, 04/23/04,

04/07/04, and 03/11/04 are in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statements are being considered by the

examiner.

### Claim Rejections - 35 USC § 101

2.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Software, *per se*:

The claims lack the necessary physical articles or objects to constitute a machine or a
manufacture within the meaning of 35 USC 101. They are clearly not a series of steps
or acts to be a process nor are they a combination of chemical compounds to be a
composition of matter. As such, they fail to fall within a statutory category. They are, at
best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or
"nonfunctional descriptive material." Both types of "descriptive material" are nonstatu-
tory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759.
When <u>functional</u> descriptive material is recorded on some computer-readable medium, it
becomes structurally and functionally interrelated to the medium and will be statutory in
most cases since use of technology permits the function of the descriptive material to be
realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed.
Cir. 1994)

Merely claiming <u>non</u>functional descriptive material, i.e., abstract ideas, stored on a
computer-readable medium, in a computer, or on an electromagnetic carrier signal,
does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that
the claims for an algorithm in *Benson* were unpatentable as abstract ideas because
"[t]he sole practical application of the algorithm was in connection with the programming
of a general purpose computer.").

Examples:

1.      A computer program product for . . . .

Claims 6-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.


### *Claim Rejections - 35 USC § 102*

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.      Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Naik et

al. (Naik) US Pub. No. 2006/0294238.


5.      Regarding claim 1, Naik discloses a network comprising: a first computer linked

to a second computer (see pg. 3, par. [0049]; resources are connected via the computer

network), the first computer having a first service and the second computer having a

second service (see pg. 3, par. [0031]; grid resource management system that provides

grid services), the first and second services handling at least locating, reserving,

allocating, monitoring, and deallocating one or more computational resources for an

application, the service (see pg. 2-3, par. [0025-0032]; key components of the present

invention), upon receipt of a command, loads new instructions to modify current

instructions residing in the service that modifies a behavior of the service without

restarting the service (see pg. 3, par. [0032]; grid resource management system and

client management system).

6.      Regarding claim 2, the limitations of this claim has already been addressed (see

claim 1 above).

7.      Regarding claim 3, Naik discloses a method comprising: receiving a message

having a command for a service that handles locating, reserving, allocating, monitoring,

and deallocating one or more computational resources for an application running on a

computer in a network (see pg. 2-3, par. [0025-0032]; client request manager, key

components of the present invention);

loading a first set of instructions from a location remote from the service in response to

the command (see pg. 10, par. [0128]; accessing remotely); replacing a portion of

instructions for the service with the first set of instructions (see pg. 3, par. [0034];

backend server); and executing the service according to the first set of instructions (see

pg. 3, par. [0036]).

8.      Regarding claim 4, the limitations of this claim has already been addressed (see

claim 3 above).

9.      Regarding claim 5, Naik discloses the method of claim 3 further comprising:

modifying a relationship between the service and a second service in response to the

command (pg. 10, par. [0124]), wherein the second service comprises locating,

reserving, allocating, monitoring, and deallocating one or more computational resources

for an application running on a computer in the network (see pg. 2-3, par. [0025-0032];

key components of the present invention).


10.     Regarding claim 6, Naik discloses a computer program product, the computer

program product being operable to cause a data processing apparatus to (pg. 1, par

[0011]): receive a message having a command for a service comprises locating,

reserving, allocating, monitoring, and deallocating one or more computational resources

for an application running on a computer in a network (see pg. 2-3, par. [0025-0032];

client request manager, key components of the present invention);

load a first set of instructions from a location remote from the service in response to the

command (see pg. 10, par. [0128]; accessing remotely); replace a portion of instructions

for the service with the first set of instructions; and execute the service according to the

first set of instructions (see pg. 3, par. [0036]).


11.     Regarding claim 7, the limitations of this claim has already been addressed (see

claim 6 above).

12.     Regarding claim 8, Naik discloses the computer program product of claim 6

wherein the computer program product is further operable to cause a data processing

apparatus to modify a relationship between the service and a second service in

response to the command (pg. 10, par. [0124]), wherein the second service comprises

locating, reserving, allocating, monitoring, and deallocating one or more computational

resources for an application running on a second computer in the network (see pg. 2-3,

par. [0025-0032]; key components of the present invention).


### Conclusion

13.     The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a

list of relevant prior art.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Umar Cheema whose telephone number is 571-270-

3037.  The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William Vaughn, Jr. can be reached on 571-272-3922.  The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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